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| 09/692,498 | 10/19/2000 | Dmitry Paperny | 2509/250 | 6742 |

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| EXAMINER | |
|---|---|
| NGUYEN, CAO H | |
| ART UNIT | PAPER NUMBER |
| 2173 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 03/19/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/692,498 | PAPERNY ET AL. | |
| | Examiner | Art Unit | |
| | Cao (Kevin) Nguyen | 2173 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *23 August 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-17,19-23,25-74 and 77-98* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17,19-23,25-74 and 77-98* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17, 19-24, 25-74 and 77-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bright (US Patent No. 6,657,647) in view of Powers et al. (US Patent No. 6,362,817).

Regarding claim 1, Bright discloses a method for overlaying an object in a window of a software application (see abstract), comprising the steps of receiving a request for the object to be displayed in the window (see col. 3, lines 9-21), the request being initiated by a behavior of a user viewing the window, creating an overlay plane including the object as a function of the receiving step (see col. 4, lines 11-21). However, Powers fails to explicitly teach displaying the object, in response to the request, by overlaying the created overlay plane in the window,

wherein the object is displayed in a manner that is independent of a movement of a pointing device.

Powers teaches displaying the object, in response to the request, by overlaying the created overlay plane in the window, wherein the object is displayed in a manner that is independent of a movement of a pointing device (see col. 4, lines 1-40). It would have been obvious to one of ordinary skill in the art, having the teachings of Bright and Powers before him at the time the invention was made, to modify the displaying overlay object of Bright to include the pop-up images, as taught by Powers. One would have been motivated to make such a combination in order to produce an image and pop-up of an object upon positioning the mouse cursor within a predetermined proximity of the hyperlink or hot spot.

Regarding claim 2, Bright discloses wherein the window is a markup language document (see col. 4, lines 20-26).

Regarding claim 3, Bright discloses wherein the mark-up language document is an HTML document (see col. 5, lines 55-67).

Regarding claim 4, Powers discloses wherein the markup language document is an XML document (see col. 14, lines 25-38).

Regarding claim 5, Bright discloses wherein the software application is a Web browser (see col. 6, lines 55-65).

Regarding claim 6, Bright discloses wherein the Web browser is at least one of Netscape Navigator, Netscape Communicator, and Microsoft Internet Explorer (see col. 7, lines 1-55).

Regarding claim 7, Bright discloses wherein the receiving step includes receiving the request as a result of the user clicking on a hyperlink (see col. 8, lines 7-35).

Regarding claim 8, Bright discloses wherein the receiving step includes receiving the request as a result of the user clicking on a banner (see figures 1-2).

Regarding claim 9, Bright discloses wherein the receiving step includes receiving the request as a result of the user clicking on a graphical icon (see col. 8, lines 45-55).

Regarding claim 10, Bright discloses wherein the receiving step includes receiving the request as a result of the user initiating a click event (see col. 9, lines 17-43).

Regarding claim 11, Powers discloses wherein the receiving step includes receiving the request as a result of the user initiating a rollover event (see col. 13, lines 18-55). One would have been motivated to make such a combination in order to produce an image and pop-up of an object upon positioning the mouse cursor within a predetermined proximity of the hyperlink or hot spot.

Regarding claim 12, Powers discloses wherein the receiving step includes receiving the request as a result of the user initiating a timing event (see col. 14, lines 1-14).

Regarding claim 13, Powers discloses wherein the receiving step includes receiving the request as a result of the user requesting a new window to be displayed (see col. 14, lines 24-30).

Regarding claim 14, Powers discloses wherein the new window is defined by a markup language document (see col. 14, lines 30-37).

Regarding claims 15 and 16, Powers discloses wherein the markup language document is an HTML document and wherein the markup language document is an XML document (see col. 14, lines 39-48).

As claims 17 and 19 are analyzed as previously discussed with respected to claims 1-16 above.

Claims 20-21 and 23 differs from claim 1 in that "creating an overlay plane using at least one layer including the object as a function of the receiving step, wherein the layer is created using a layering functionality of the software application and the layer is hidden from a user; and displaying the object, in response to the request, by overlaying the layer in the window, wherein the object is displayed in a manner that is independent of a movement of a pointing device" which recited on Bright, see col. 11, lines 1-30.

Regarding claim 22, Powers discloses the layer is a DHTML layer (see col. 24, lines 20-37).

As claims 25 and 26 are analyzed as previously discussed with respected to claims 22-23 above.

Regarding claim 27, Bright discloses wherein the displaying step further comprises: displaying the object, in response to the request, by overlaying the created overlay image in the window, wherein the object is displayed in a manner that is independent of a movement of a pointing device (see figures 2-4)

Regarding claim 28, Powers discloses, wherein the overlay plane utilizes semi-transparent edges (see col. 28, lines 20-35).

Regarding claim 29, Power discloses, wherein the displaying step includes the step of using a transition effect to display the created overlay plane, wherein the transition effect is at least one of a transparent transition, a rotating object transition, a zoom transition, an animation transition, a wipe transition, a page curl transition, and a ripple transition (see col. 28, lines 20-67 and col. 29, lines 1-67). It would have been obvious to one of ordinary skill in the art, having the teachings of Bright and Powers before him at the time the invention was made, to modify the

displaying overlay object of Bright to include the pop-up images, as taught by Powers. One would have been motivated to make such a combination in order to produce an image and pop-up of an object upon positioning the mouse cursor within a predetermined proximity of the link or hot spot.

Regarding claim 30, Powers discloses, wherein the displaying step further comprises: displaying the object, in response to the request, by overlaying the created overlay plane in the window, wherein the overlay plane is directly composited with the window without using functionality of the software application and wherein the object is displayed in a manner that is independent of a movement of a pointing device (see figures 8A-8C).

Claims 31 and 47 differs from claims 1 and 20 in that "receiving, by a plugin-control, a request for the object to be displayed in the window, the request being initiated by a behavior of a user viewing the window creating, by the plugin-control, an overlay plane including the object as a function of the receiving step; and displaying the object in response to the request by overlaying, by the plugin-control, the created overlay plane in the window, wherein the object is displayed in a manner that is independent of a movement of a pointing device" which read on Powers; see col. 14, lines 1-15 and figures 4Q-4S. It would have been obvious to one of ordinary skill in the art, having the teachings of Bright and Powers before him at the time the invention was made, to modify the displaying overlay object of Bright to include the pop-up images, as taught by Powers. One would have been motivated to make such a combination in order to produce an image and pop-up of an object upon positioning the mouse cursor within a predetermined proximity of the link or hot spot.

As claims 32-46 and 50-51 are analyzed as previously discussed with respected to claims

27-31 above.

Regarding claims 47 and 48, Powers discloses, wherein the displaying step further comprises displaying the object in response to the request by overlaying, by the plugin-control, the layer in the window, wherein the layer is overlaid in the window using a plugin-control provided mechanism for a display of content in the window by passing a software application provided mechanism for a display of layers and wherein the object is displayed in a manner that is independent of a movement of a pointing device (see figures 4A-4S).

Regarding claim 52, Powers discloses, wherein overlaying an object in a window of a software application, comprising the steps of receiving, by a plugin-control, a request for the object, the request being initiated by a behavior of a user viewing the window, creating, by the plugin-control, an overlay plane including the object as a function of the receiving step; defining a layer using the software application provided functionality, wherein the layer definition is included in the definition of the window; placing the created overlay plane in the defined layer; and overlaying, by the plugin-control, the created overlay plane in the window (see col. 6, lines 5-61 and figures 1-3). One would have been motivated to make such a combination in order to produce an image and pop-up of an object upon positioning the mouse cursor within a predetermined proximity of the link or hot spot.

As claims 53-74 and 77-94 are analyzed as previously discussed with respect to claims 32-52 above.

Regarding claim 95, Powers discloses a method for overlaying an object in a window of a software application, displaying the object in response to the request by overlaying, by the plugin-control, the created overlay plane in the window, wherein the object is displayed in

a manner that is independent of a movement of a pointing device and wherein the overlay plane is directly composited in the window without using a layering feature of the software application (see col. 7, lines 1-64).

Regarding claim 96, Powers discloses creating, by the plugin-control, an overlay plane including the object as a function of the receiving step; and displaying the object in response to the request by overlaying, by the plugin-control, the created overlay plane in the window, wherein the object is displayed in a manner that is independent of a movement of a pointing device and wherein the overlay plane is directly composited in the window without using a layering feature of the software application (see figures 1-5). One would have been motivated to make such a combination in order to produce an image and pop-up of an object upon positioning the mouse cursor within a predetermined proximity of the link or hot spot.

As claims 97-98 are analyzed as previously discussed with respect to claims 95-96 above.

***Response to Arguments***

Applicant's argument filed on July 15, 2005 has been fully considered, but they are not persuasive.

In response to applicant's argument on pages 22-25 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, Bright discloses documents to be rendered by a browser used in combination of Power's system for creating and viewing 2D and 3D environments used in combination of Power. One would have been motivated to make such a combination in order to displaying a window by creating overlaying object or window by default.

In response to applicant's argument that displaying the object, in response to the request, by overlaying the created overlay plane in the window,, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

On pages 22-23 of the Remark; Applicant argue that Bright and Powers do not teach or suggest creating and rendering an overlay plane. The limitations as claimed broadly read, as shown in figure 1, Bright teaches a logo graphic object is displayed at the top of frame, which additionally includes a "MARKETS" text header, an "INVESTMENTS" text header, and a plurality of links with overlaying graphic objects, including a "DOW" link, a "NASDAQ" link, an "OPTIONS" link, a "CHARTS" link, a "MUTUAL FUNDS" link, a "IRA, 401K OPTIONS" link, and a "TAX INFORMATION" link; as recited in col. 3, lines 8-23.

On pages 22-23 of the Remark; Applicant argue that Bright and Powers do not teach or suggest creating and rendering an overlay plane. The limitations as claimed broadly read, as shown in figure 1, Bright teaches a partially rendered webpage corresponding to webpage and the text of object while most of the graphic objects are rendered; as recited in col. 8, lines 35-55.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of

the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections, as recited in col. 3, lines 8-24.

Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the art of record.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cao (Kevin) Nguyen
Primary Examiner
Art Unit 2173

03/15/07